

REMARKS

This Response, filed in reply to the Office Action dated November 17, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-13 and 15-18 are all the claims pending in the application.

Claims 1-5, 10, and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 6,771,896).

Claims 1-5, 6-9, 10, 12, 15 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 6,771,896), Dawe (Article) and Chui et al. (U.S. Patent No. 6,657,702).

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 6,771,896), Dawe (Article) and Chui et al. (U.S. Patent No. 6,657,702) as applied to claims 6-9 and 12 and further in view of Cone et al or Narayanaswamy et al.

All references are previously of record. Applicant respectfully submits the following arguments in traversal of the prior art rejections.

Applicant's invention relates to methods and apparatus for providing confirmation of image data, such as via thumbnail of images, which are printed by a voucher printer separate from an image printer. In particular, a voucher printer prints a voucher including thumbnail images and details on order information for the image data. As an alternative method of confirmation, the technique of the present invention includes sending electronic mail, after an

order has been placed, which includes thumbnail information and order information. This electronic mail is delivered to the person who placed the order.

The Examiner continues to contend that Tamura teaches each feature of independent claim 1. For the reasons of record, the Examiner combines different embodiments of the Tamura disclosure without basis to do so. Thus, the rejection is improper. Moreover, Applicant submits that even assuming *arguendo* that it is proper for the Examiner to combine the different embodiments, their combination does not teach each feature of claim 1.

Claim 1 describes a voucher printer which is 1) separate from an image printer, to print a voucher including the 2) details of a print order and 3) thumbnail images of the order. No printer or combination of printers in Tamura teaches all these aspects of the voucher printer. In particular, the printer 212 of a first embodiment of Tamura does not print a thumbnail, and the printer 130 of the second embodiment of Tamura is the same printer that prints the image data. The Federal Circuit has indicated that when a claim element includes multiple features, the prior art must also teach the element with the multiple features. *Kimberly Clarke Corp. v. J & J Personal Products*, 223 USPQ 603, 609-610 (Fed. Cir. 1984). In this situation, none of the printers in Tamura will 1) print both a) voucher with order information detail and b) a thumbnail and also 2) be separate from the image printer. Therefore, claim 1 is patentable for at least this reason.

The Examiner's rejection also suggests that it would be obvious to one skilled in the art to include multiple printers to teach a thumbnail printer separate from an image printer. However, the Examiner's rationale, at best, teaches that three printers are used to print three

different outputs 1) the image data; 2) the voucher and 3) the printer. The inclusion of additional printers still does not lead to a printer with the dual characteristics of printing a voucher with a) order details and b) thumbnail images. Therefore, claim 1 is patentable for this additional reason.

The Examiner contends that the use of a thumbnail as a hard copy confirmation is sufficient to support the rejection. This contention is incorrect because it ignores the multiple characteristics of the voucher printer. The thumbnail confirmation can provide its confirmation function whether it is printed by the same printer as the image data or by an additional third printer. There is no requirement that the confirmation thumbnail must be printed by the same voucher printer that prints the details of the order. Therefore, claim 1 is patentable for this additional reason.

Because claim 10 includes recitations analogous to that set forth above for claim 1, claim 10 is patentable for the reasons set forth above. Claims 2-5 and 16-18 are patentable based on their dependency.

The Examiner also rejects claim 1 over the combination of Tamura, Dawe and Chui. However, Dawe and Chui do not make up for the above deficiencies of Tamura. In particular, because Dawe relates to confirmation of computer orders, Dawe fails to teach any aspect of thumbnail image printing. Chui teaches no embodiment where a single printer, separate from an image printer, prints both a voucher including order details and a thumbnail.

The Examiner's rebuttal at paragraph 7 of the detailed action contends that it is not sufficient for Applicant to note the deficiencies of the references individually when the rejection

is being made based on a combination. However, Applicant submits that the deficiency does lie in the deficient teachings of the combination. Even assuming that Tamura, Dawe and Chui are properly combined, their combination still fails to teach the voucher printer with the multiple characteristics as claimed. The Federal Circuit decision in Kimberley Clarke indicates that the rejection in this situation should be withdrawn.

Therefore, claims 1 and 10 and their dependent claims are patentable over the combination of Tamura, Dawe and Chui.

With regard to the rejection of claim 6 over the combination of Tamura, Dawe and Chui, Applicant submits that the rejection is improper. Claim 6 describes the transmission of an electronic mail message with a) the order information and b) thumbnail. Tamura alone provides confirmation of the print order at the location where the order is placed via printer 212. There is no reason to transmit this information redundantly to the person who placed the order by email. This indicates that the Examiner's proffered motivation is strictly the result of improper hindsight.

The Examiner also concedes that Tamura does not teach the transmission of thumbnail data and cites Dawe and Chui to make up the deficiency. With regard to Dawe, this reference does not transmit any thumbnail images. Therefore, Dawe clearly does not make up the deficiencies of Tamura. With regard to Chui, the Examiner cites col. 1, lines 45-67, col. 17, lines 25-40, col. 21, lines 40-50 and Fig. 9. No aspect of Chui supports the rejection. Col. 1 merely refers to transmission of the image data itself, not thumbnail information. Cols. 17, 21 and Fig.

21 all relate to sending of emails to third party recipients. None of the cited portions describe email of thumbnail information to the person who placed the order as describe by claim 6.

This argument was previously submitted, and the Examiner has yet to rebut this basis for withdrawal of the rejection.

Thus, the cited combination fails to teach all aspects of claim 6. Claim 11 is patentable based on analogous recitations. The remaining claims are patentable based on their dependency.

Cone and Narayanaswamy do not make up for the above deficiencies of Tamura, Dawe and Chui.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appl. No. 09/863,476

Attorney Docket No. Q64648

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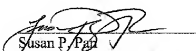
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